



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,901	04/11/2000	Kenji Sakanashi	JEL31058	4835

7590 05/07/2004

Stevens Davis Miller & Mosher LLP
1615 L Street NW
Suite 850
Washington, DC 20036

EXAMINER

NGUYEN, THUAN T

ART UNIT	PAPER NUMBER
----------	--------------

2685

DATE MAILED: 05/07/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/547,901

Applicant(s)

SAKANASHI, KENJI

Examiner

THUAN T. NGUYEN

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 14-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/11/00 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3-4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, drawn to a portable telephone apparatus for telephone and hearing music, classified in class 455, subclass 556.1.
- II. Claims 14-16, drawn to a (separate) audio apparatus with data compression means and removable storage and means for writing compressed music data to the removable storage, classified in either class 381/118 or class 381/334.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I, and II are related as combination and subcombinations. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because invention I drawn to a portable telephone apparatus for telephone and hearing music, classified in class 455, subclass 556.1. The subcombination has separate utility whereas invention II is about a (separate) audio apparatus with data compression means and removable storage and means for writing compressed music data to the removable storage, classified in either class 381/118 or class 381/334. Invention I and II are clearly distinct from each other, as disclosed by the specifications, invention I and invention II disclose two separate devices coupled to each other at connection means 15 (Figs. 1-2, and 4-7). See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 2685

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Applicant's election with traverse of claims 14-16 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the search and examination of the entire application can be made without serious burden (to the Examiner). This is not found persuasive because as stated in earlier statements, it would give serious and extra burden to the Examiner since he has to search more for other classes/subclasses and spend more extra times (the examiner has a very limited time for performing the entire searching and writing the Office Action for one application) to see whether the different limitations are taught elsewhere in audio class 381, which is not a main class belongs to the Examiner's expertise.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Segal et al. (US Patent 6,167,251).

Regarding claims 1-13, Segal already discloses a portable telephone apparatus using for both telephone and hearing music (Fig. 1 for a portable telephone communicates with a base station, and col. 11/line 45 to col. 12/line 25 & Fig. 29, col. 29/line 18-37 for listening to music channels), wherein the apparatus comprising an antenna for communicating with a base station or a parent unit (Figs. 1 & 3, Fig. 3/item 62 for an antenna); a voice input unit as a microphone (Fig. 5/item 76 for a microphone); a voice output unit as a speaker (Fig. 5/item 74 for a speaker); further including operate keys and a display unit for a user to navigate and operate the apparatus, i.e., keys is conventional and known in the art (col. 2/lines 4-26) and a display 48 is shown (Fig. 3); including a telephone control unit (Fig. 5/item 66 for a microprocessor in controlling the apparatus) for modulating a radio signal from the voice input and output the modulated signal to the to the antenna and demodulating the signal received through the antenna, extracting a voice signal and outputting the voice signal (Fig. 5, using A/D and D/A for

Art Unit: 2685

converting the signal received signals through antenna 62 for outputting voice signal at the speaker 74, and converting the user voice signal received at the microphone 76 into radio signals for processing at the microprocessor 66; Fig. 5, col. 14/line 7 to col. 15/line 16); a chargeable battery for supplying power to the apparatus (col. 1/line 55 to col. 2/line 3 & col. 28/line 1-35 for energy 54 is rechargeable); a storage unit for storing the compressed music data (Fig. 5, memory 86 for storage; and the downloadable music can be in MP3 format or compressed format for later use, see col. 30/lines 15-32); a data restoration unit for reading, expanding, and reproducing as a music signal the data stored in the storage unit (col. 30/lines 25-32 for suggesting to include functions for playing back the stored music data); and a switching unit for selecting the telephone function or listening the music data function 9col. 17/line 63 to col. 18/line 14 for switching the apparatus on, and col. 30/lines 25-37 indicates the activation of playing music playback if the user desires).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kaganas et al (US Patent 6,425,018 B1), Suzuki (US Patent 5,956,655), Palermo (US Patent 5,982,764), Schulhof et al. (US Patent 5,572,442), and Borland et al. (US Patent 6,556,965 B1) disclose portable communication systems with playing music.

Art Unit: 2685

10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:


(703) 872-9306, (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II,

2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tony Thuan Nguyen whose telephone number is (703) 308-5860. The examiner can normally be reached on Monday-Friday from 9:30 AM to 7:00 PM, with alternate Fridays off.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600 Customer Service Office** whose telephone number is **(703) 306-0377**.



TONY T. NGUYEN
PATENT EXAMINER, *FS**

Tony T. Nguyen
Art Unit 2685
April 29, 2004